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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,928	04/08/2004	Philip F. Williams III	OSTEONICS 3.0-477	8757
530	7590	07/03/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			IZQUIERDO, DAVID A	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/820,928	WILLIAMS ET AL.	
	Examiner	Art Unit	
	David A. Izquierdo	3738	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-23 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10 and 12-15 is/are rejected.
- 7) ☒ Claim(s) 8, 11 and 16-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

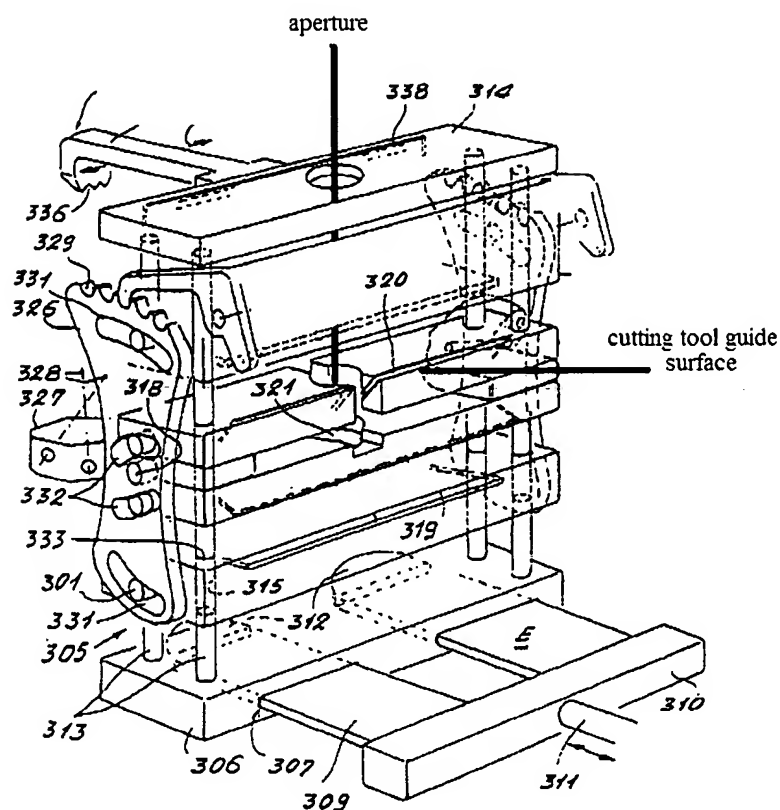
**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments filed 3/24/06 in regards to claims 1-7, 9, 10, 12 and 13 have been fully considered but they are not persuasive. Applicant has argued that neither Duvillier et al. nor Lionberger et al. teach a first body and a second body where at least one aperture of the first body communicates with a cutting tool guide surface of the second body (Remarks: pages 7, lines 31-33 and page 8, lines 1-6). However, it is clear from Figure 3 (shown below) of Duvillier et al. that the cutting tool guide surface is in communication with the aperture of another body.



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Furthermore, Applicant has argued that the combination of Duvillier et al. and Lionberger et al. fails to teach the use of both a polymeric and non-polymeric material. However, simply combining two elements within a device does not render a device patentable over prior art. It would have been obvious to anyone skilled in the art to combine different materials in one device, especially materials as in described as polymeric and non-polymeric.

Applicant's arguments, see Remarks: page 7, lines 27-33, filed 3/24/06, with respect to the rejection(s) of claim(s) 14 under U.S.C. 102 (b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Owens under U.S.C. 103 (a). With regard to Applicants previous arguments stating that Owens et al. is outside the field of the current invention, the structure of the prior art clearly reads on the claimed structure of Applicants invention. Furthermore, the addition of functional language does not overcome the prior art, as the prior art is still capable of performing the task at hand.

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### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 10, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duvillier et al (U.S. Patent Number 5,749,876) in view of Lionberger et al. (U.S. Patent

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Application Publication Number 2004/0260301). Duvillier et al discloses a bone cutting apparatus comprising:

- A first body (302) portion having an aperture extending therethrough (Claim 1);
- A stainless steel second body portion (303) coupled to the first body portion wherein the second body portion comprises a cutting slot in communication with the aperture of the first body portion and further comprising a first surface and a second surface which face the bone and the first body portion respectively (Claims 1, 2, 6, 7, 9, 10);
- A stainless steel third body portion (301) coupled to the first body portion wherein the third body portion comprises a cutting surface in communication with the aperture of the first body portion and the cutting surface of the second body portion (Claim 3, 6, 7);
- Pins (313) which interact with all body portions and further secure the body portions to the bone surface (Claims 4, 5, 12, 13);

however Duvillier et al. fails to disclose a bone cutting apparatus comprising a polymeric material. Lionberger et al. teaches a guide made of a polymer (claim 28, line 2). It would have been obvious to one of ordinary skill in the art to combine the teaching of a polymeric guide, or body portion, as taught by Lionberger et al., to a bone cutting apparatus, as per Duvillier, the motivation to combine being that a polymeric material allows for the guide to be manufactured of disposable material allowing for guide to be single use, eliminating error cause by wear on the guide, as found in Lionberger et al. (claim 28, line 2).

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being anticipated by Owens et al. (U.S. Patent Number 6,393,958) in view of Neal (U.S. Patent Number 4,075,920). Owen et al. discloses:

- a plastic base portion having a first side and second side with three slots extending therebetween,
- a first guide portion having four slots,
- a second guide portion having four slots,

wherein the first guide portion is attached to the first side of the base portion and the second guide portion is attached to the second side of the base portion and all slots are in communication with the respective slots in adjacent portions.

However Owens et al. fails to disclose a polymeric material in combination with a non-polymeric material. Although it would have been obvious to one of ordinary skill in the art at the invention to use multiple materials within a cutting guide, Neil has been provided to illustrate a specific example. Neil teaches the use of multiple materials, specifically a combination of polymeric materials and non-polymeric materials within a cutting guide. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine multiple materials in a cutting guide, as taught by Neil (col. 3, lines 40-45) to a mitre box, as per Owens et al. The motivation to combine being that the use of a non-metallic material provides for a lighter guide while the addition of metallic components provides a greater resistance in areas likely to be struck by the saw.

***Allowable Subject Matter***

Claims 20-23 are allowable over the prior art of record.

Claims 8, 11, and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Izquierdo whose telephone number is 571-272-1943. The examiner can normally be reached on Monday through Friday from 8:00 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David A. Izquierdo

*Thomas Barrett*  
Primary Examiner